

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-5, 7 and 10-24 are now present in this application. Claim 1 is independent.

By this Amendment, amendments have been made to the specification to make the specification internally consistent, to make the specification consistent with the drawings, and to reflect a corrected English language translation of Applicants' Japanese language PCT application; claims 6, 8 and 9 have been canceled without prejudice, and claims 1, 7 and 10 have been amended. Support for the claim amendment is found in the Application as originally filed and in the aforementioned amendment of the paragraph bridging pages 22 and 23 of the specification, which is based on the aforementioned corrected English language translation. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority documents. Applicants respectfully ask the Examiner to determine if box 12(a)(3) on the Form PTOL-326 should also be checked inasmuch as this Application is a PCT National Stage entry under 37 USC §371.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statements filed on March 3, 2005, July 22, 2005, and April 18, 2007, and for providing Applicants with initialed copies of the PTO/SB/08 forms filed therewith.

Election of Species Requirement

The Examiner has made the Election of Species Requirement final, and has withdrawn claims 14-17 and 20-24 from further consideration. Applicant has not canceled these non-elected claims since each of these claims depends, either directly or indirectly, from independent generic claim 1, which is believed to be allowable.

Applicants continue to traverse the election of species requirement for the detailed reasons presented in the Reply to Election of Species Requirement, which was filed on February 23, 2009, which are incorporated herein by reference thereto.

Applicants respectfully note that the outstanding Office Action fails to apply the principles of Unity of Invention to this election of species requirement, as required by 37 CFR §1.499, which is entitled, "Unity of invention during the national stage." Because this Application is the national stage entry of a PCT International Application, filed under 35 USC §371, the USPTO must follow Unity of Invention criteria per 37 CFR §1.499 which are found in 37 CFR 1.475, MPEP §1893.03(d), and PCT Administrative Instructions, Annex B – see MPEP §AI-58+.

Unfortunately, the provisions of 37 CFR §1.475 are not even addressed in the outstanding

Office Action.

This failure to even address the requirements of 37 C FR 1.475, MPEP §1893.03(d), and PCT Administrative Instructions, Annex B means that the election of species requirement is fatally flawed and should be withdrawn.

Further in this regard, Applicants respectfully submit that in a Unity of Invention (UOI) determination, claims having allowable commonly recited technical features have to be identified before unity of invention is determined to exist or not exist. In the UOI situation, the Examiner has to review the claims ahead of time, determine the existence or nonexistence of commonly recited technical features, and determine whether or not those commonly recited features are special, regardless of whether an election of species situation is presented. This clearly has not been done.

Additionally, the outstanding Office Action fails to address the Applicants' contention that the election of species requirement is flawed because it ignores the clear policy statement in MPEP §806.04(f), brought to the Examiner's attention in the Reply filed on February 23, 2009, that claims to be restricted to species must be mutually exclusive, i.e., for claims to be properly restricted to different species, those claims must recite the mutually exclusive characteristics of such species. However, each and every pending dependent claim recites all of the features of generic claim 1 (which is clearly admitted by the examiner to be a generic claim) and, thus, none of the pending dependent claims, i.e., claims 2-5, 7 and 10-24 are not mutually exclusive.

Accordingly, the election of species requirement is fatally flawed for this reason, as well as for the reasons discussed above. In other words, claims 1-5, 7 and 10-24 are not mutually

exclusive and must be examined together.

Applicants thank the Examiner for addressing the serious burden issue. However, the fact that separate searches will be required for certain features of dependent claims is trumped by the USPTO's policy requirement that claims that are not mutually exclusive from one another cannot be the subject of an election of species requirement.

Accordingly, the election of species requirement is improper. Reconsideration, withdrawal of these requirements, and examination of all pending claims, i.e. claims 1-5, 7 and 10-24, are respectfully requested.

Specification Amendments

Applicants have amended the specification in order to correct a typographical error which mis-identified "container body 3" as "container body 2."

Applicants have also amended the specification based on a corrected translation of one of Applicants' Japanese PCT Patent Applications, PCT/JP2003/010365 with respect to which this Application is the U.S. National Stage Entry. A copy of the corrected translation of PCT/JP2003/010365 is enclosed, along with a statement of a person who is familiar with both the Japanese and English languages to the effect that the corrected translation is accurate.

Rejection Under 35 U.S.C. § 102

Claims 1-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by SHO 49-07245 to Takihara. This rejection is respectfully traversed.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *See Zurko v.*

Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *See Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claim 1, as amended, recites a backflow preventing plug including a thin film resilient membrane defining a flow path having an intake port and an outlet port, a ball-shaped plug member retained between the intake port and the outlet port in the flow path in the resilient membrane and formed with a spherical sealing surface for restricting flow of fluid by coming into resilient contact with a middle portion of the resilient membrane; and clearance forming means comprising at least one of the following: a plurality of projection portions each of which has a shape of projection and which are located at such positions on an inner surface of the resilient membrane as to be closer to the outlet port than to a center of the ball-shaped plug member and to be apart from each other and substantially symmetrically located about a circumferential surface of the ball-shaped plug member; a plurality of projections extending from an outer surface of the ball-shaped plug member toward the resilient membrane, said projections being closer to the outlet port than to a center of the ball-shaped plug member and to be apart from each other and substantially symmetrically located about a circumferential surface of the ball-shaped plug member; and a plurality of recesses formed in a recess shape which are

located at such positions on the plug member as to be closer to the outlet port than to the center of the ball-shaped plug member and be apart from each other and substantially symmetrically located about a circumferential surface of the ball-shaped plug member and which communicate with each other at closest positions to the outlet port.

Applicants respectfully submit that Takihara does not contain an anticipatory disclosure of this claimed invention. For example, the claimed projection features and the claimed recess feature are totally absent from Takihara.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takihara in view of U.S. Patent 5,529,213 to Mack et al. ("Mack"). This rejection is respectfully traversed.

Applicants respectfully submit that Takihara does not disclose or suggest the invention recited in claim 1, from which claims 18 and 19 depend, and that Mack is not applied to remedy the shortcomings of Takihara with respect to claim 1, so even if one of ordinary skill in the art were properly motivated to modify Takihara, as suggested, the so-modified version of Takihara would still not disclose, suggest, or otherwise render the claimed invention obvious.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

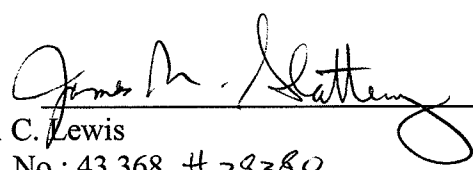
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: August 31, 2009

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

PCL/RJW:mmi:jmc

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Enclosure: Corrected English language translation of PCT/JP2003/010365 (56 pages)
Statement of accuracy of the corrected English language translation (2 pages)